PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Jagmohan SINGH, et al.

Application No.: 10/813,156

Confirmation No.: 4448

Filed: 31 March 2004

Docket No: Q80880

Group Art Unit: 1633

Examiner: Maria Marvich

For: NOVEL TEMPERATURE REGULATED PROMOTERS AND EXPRESSION VECTORS FOR PROTEINS FROM SCHIZOSACCHAROMYCES POMBE

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This responds to the Restriction Requirement, dated 23 March 2007. In response to the Restriction Requirement, Applicant elects Group I, claims 1-24 for examination, with traverse. In addition, Applicant reserves the right to file divisional applications directed to any non-elected claims.

The restriction requirement of March 23rd restricts the pending claims into four groups. According to the Office Action, Group I, claims 1-24, is "drawn to nmt-185 (SEQ ID NO:1), classified in class 536, subclass 24.1;" Group II, claims 1-24, is "drawn to nmt-146 (SEQ ID NO:2), classified in class 536, subclass 24.1;" Group III, claims 25-62 is "drawn to a method of isolating a promoter and preparing vectors with the nmt-185 promoter" and; Group IV, claims 25-62 "drawn to a method of isolating a promoter and preparing vectors with the nmt-146 promoter."

In making the restriction requirement, the Office Action asserts that "[i]nventions I and II are directed to related products." *Office Action of 23 March 2007,* page 2. Further, the Office Action states that the "related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have materially different design, mode of operation, function or effect." *Office Action of 23 March 2007,* page 2.

In support of the restriction, the Office Action alleges that "the promoters [of Groups I and II] are structurally distinct as evidenced by their distinct structural sequences and functionally these sequences … have distinct functions endogenously." *Office Action of 23 March 2007,* page 2. In addition, the Office Action alleges that "[a] search for art pertaining to nmt-185 is not overlapping with a search for art for nmt-146."

Applicants respectfully disagree with the Office Action's assertion that Groups I and II are distinct or unrelated. The Manual of Patent Examining Procedure (MPEP) states that invention can be shown as unrelated if "(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent." (MPEP, 8th Ed., § 806.06). Further, this same passage provides examples of when inventions are unrelated, such as "[a]n article of apparel such as a shoe, and a locomotive bearing, [or] [a] process of painting a house and a process of boring a well…." *Id.* Thus, the MPEP makes it clear, with its guidelines and examples, when two inventions should be considered unrelated. This is not the case in the present application.

Indeed, the two promoters, nmt-185 and nmt-146 were isolated from the same screening process involving construction of a genomic library of *S. pombe.* The promoters were placed in front of a GFP reporter and colonies were assayed for fluorescence upon exposure to UV radiation, following growth at 36°C and 25°C. Upon further testing, both promoters showed similar behavior of induction of expression of GFP and other genes upon shifting the temperature from 36°C to 25°C. The behavior is very similar both qualitatively and quantitatively for the two promoters. Thus, Applicants assert that, contrary to the Office Action, the nmt-185 and nmt-146

promoters (Groups I and II, respectively) do not have a "mutually different … mode of operation or function or effect."

Furthermore, Applicants assert that searching Groups I and II would not be a "serious burden" to the Office. The Office is reminded that "[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions" (MPEP, 8th Ed., §803). Applicants point out that the nucleotide sequence of the nmt-185 promoter comprises the sequence of the nmt-146 promoter. Thus, "searching for art pertaining to the nmt-146 promoter" would necessarily comprise and overlap a search for art pertaining to the nmt-185 promoter. In fact, Applicants assert that examining the nmt-146 promoter would be instructive to the Office and may provide helpful information for searching and examining claims drawn to the nmt-185 promoter.

Accordingly, Applicants assert that Groups I and II should be examined together, as the Groups are not unrelated as taught in the MPEP. Further, even if the Groups are unrelated, Applicants assert that there would not be a serious burden on the Examiner to search and examine Groups I and II.

For the reasons indicated above, Applicants assert that the restriction requirement is improper and should be withdrawn. At a minimum, Groups I and II should not be restricted from each other, because of the reasons set forth above. Applicants earnestly await receipt of the Office Action on the merits.

Should the Examiner believe that further discussion of any remaining issues would advance the prosecution, he or she is invited to contact the undersigned at the telephone number listed below.

If additional extensions of time are necessary to prevent abandonment of this application, then extensions of time are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required, including fees for net addition of claims, are hereby authorized to be charged to account number 19-4880.

Respectfully submitted,

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